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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,285	12/02/2003	Kurt K. Carbonero	0889.3030.001	5285

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EXAMINER

ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,285	<b>Applicant(s)</b> CARBONERO, KURT K.	
	<b>Examiner</b> Mitra Aryanpour	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 4-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, lines 9 and 10, applicant is claiming broader than what has been disclosed. Light or dark indicia implies that the indicia are associated with "lighting" and not necessarily with shading. It could also be broadly interpreted to mean right or left, heavy or light etc. The Specification as filed does not refer to the indicia as just "light or dark" but rather refer to indicia as "light or dark shading".

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Cagney, Jr. (5,330,176).

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Regarding claim 1, Cagney, Jr discloses a sporting good (planar body 12 having surface 14) comprising: a sequence indicia disposed thereon including at least one figure demonstrating an action to take with the sporting good (instruction indicia 54; see column 6, lines 5-17); the figure being shown in a sequence of positions representing the action whereby a person can view the sequence indicia, and learn and practice the action (see figure 1). Cagney, Jr further shows the figures demonstrate proper foot positioning and body motion. In order to have proper positioning and body motion the body weight needs to be properly distributed in order to achieve the desired results. Therefore, when referring to figures 2-5 it can be seen from the figures that in figures 2 and 4, the weight is on the leading foot (48) and in figures 3 and 4, the weight is evenly distributed (see column 4 and 5; stance and stride indicia). With regards to light and dark indicia, the broadest reasonable interpretation of light and or dark indicia would include the foot positioning with respect to the first and third rows in order to achieve proper weight distribution and balance.

**Additionally:**

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by McGinley (US2003/0235809A1).

Regarding claim 1, McGinley discloses a sporting good (bat 14) comprising: a sequence indicia disposed thereon including at least one figure demonstrating an action to take with the sporting good (illustrations 22); the figure being shown in a sequence of positions representing the action whereby a person can view the sequence indicia, and learn and practice the action (see

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figure 1). McGinley further shows the sequence indicia (22a-22d) include secondary indicia showing how to distribute and transfer weight during the action (see paragraph 0019; written description 24). In order to have proper positioning and body motion the body weight needs to be properly distributed in order to achieve the desired results. Therefore, when referring to figure 3 it can be seen from the set-ups 1-4 the weight is on the leading foot (48). McGinley further shows the figure (22a-22d) includes a representation of arms and legs (figure 3, shows the proper foot and arm position), and the secondary indicia, includes shading disposed on the legs. With regards to light and dark indicia, the broadest reasonable interpretation of light and or dark indicia would include the set-up steps demonstrating the foot movement in order to achieve proper weight distribution and balance.

Regarding claims 12 and 13, McGinley shows the bat (14) includes strike indicia disposed on the sporting good indicating a desired manner of striking the good and at least one legend explaining the strike indicia (see figure 3, steps 3 and 4).

**Additionally:**

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-6, 8-11, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Publicover (US2004/0076938A1) in view of Popeck (6,461,256).

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Regarding claim 1, Publicover shows a sporting good (ball 10) comprising: a sequence indicia disposed thereon including at least one figure demonstrating an action to take with the sporting good (fingertip markings 18a-18e); the figure (the hand and fingers) being shown in a sequence of positions representing the action whereby a person can view the sequence indicia, and learn and practice the action (see figure 5). Publicover further shows the sequence indicia (18a-18e, 44b and 46b) include secondary indicia showing how to distribute and transfer weight during the action (see paragraph 0050-0055). Publicover shows the figure being a representation of hands and fingers. Publicover does not disclose expressly the figure being a representation of legs. Popeck shows a training device wherein the device is provided for training a player to use the proper upper torso alignment and relative leg position when shooting a basketball. Popeck teaches that there is a need for a means by which a basketball player can maintain proper vertical alignment, proper feet position, and proper balance when shooting a basketball so as to increase shooting percentages. In view of Popeck it would have been obvious to also include on a basketball indicia representing proper vertical alignment, feet position, and balance in addition to hand placement when shooting a basketball so as to increase shooting percentages.

Regarding claim 4, Publicover shows the secondary indicia include shading disposed on the hand. Publicover shows the secondary indicia include light shading to convey the different states of release (see paragraph 0021 and 0022).

Regarding claims 5 and 6, Publicover shows the good is a basketball.

Regarding claim 7, Publicover shows the action to take with the ball is one of throwing (see paragraph 0055).

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Regarding claims 8 and 9, Publicover further shows including a legend explaining the shading and including a legend explaining the action (see figure 7).

Regarding claim 10, Publicover shows including a hand placement indicia disposed on the good indicating desired hand placements on the sporting good for handling the sporting good (see figure 5).

Regarding claim 11, Publicover shows at least one legend explaining the hand placement indicia (see paragraph 0055).

Regarding claim 15, during normal use and operation of the modified Publicover device, the method steps set forth by applicant in the claim is inherently provided.

Regarding claim 16, during normal use and operation of the modified Publicover device, the method steps set forth by applicant in the claim is inherently provided.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGinley (US2003/0235809A1) in view of Publicover (US2004/0076938A1).

Regarding claim 4, McGinley shows a hitting trainer (bat 14), comprising: a sequence indicia disposed thereon including at least one figure demonstrating an action to take with the sporting good (see illustration 22); the figure being shown in a sequence of positions representing the action whereby a person can view the sequence indicia, and learn and practice the action (see figure 1); the sequence indicia (22a-22d) include secondary indicia showing how to distribute and transfer weight during the action (see paragraph 0019; written description 24); the figure (22a-22d) includes a representation of arms and legs (figure 3, shows the proper foot and arm position), and the secondary indicia includes shading disposed on the legs (as best seen the figures as a whole is provided with shading). McGinley does not disclose expressly the

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shading including light shading and dark shading. Publicover shows several different embodiments for aiding players to correctly place their hands on sports equipment such as game balls or non-game ball objects. Publicover shows the secondary indicia include shading disposed on the hand. Publicover shows the secondary indicia include light shading to convey the different states of release (see paragraph 0021 and 0022). In view of Publicover it would have been obvious to include light and dark shading as secondary indicia on McGinley's sporting device, the motivation being to indicate the different states of release.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Publicover (US2004/0076938A1).

Regarding claim 14, Publicover does not disclose expressly the sporting good having catching indicia. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to include catching indicia on the sporting good, because Applicant has not disclosed that including catching indicia on the sporting good, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the indicia taught by Publicover or the claimed indicia because both indicia perform the same function of aiding a user to better utilize the sporting good. Therefore, it would have been an obvious matter of design choice to modify Publicover to obtain the invention as specified in claim 14.



***Response to Arguments***

10. Applicant's arguments filed 21 July 2005 have been fully considered but they are not persuasive. The use of indicia is well known in the sports training art and often placed on sports paraphernalia. The prior art of record alone or in combination demonstrate the use of indicia for demonstrating proper technique of handling a ball or a bat to a user. There is nothing unobvious in providing training indicia whether it is on one sporting element or a plurality of elements. The end result is the same.

The applicant appears to argue that "Publicover does not teach a user how to use the sporting good, but simply shows how he/she used the good, which might have been wrong." This argument, however, is not persuasive since it is speculative and is not supported by any objective evidence. *In re DeBlauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972).

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 10:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21 September 2005



**MITRA ARYANPOUR**  
**PRIMARY EXAMINER**